

REMARKS

This is in response to the Office Action mailed on October 31, 2003, in which all of the pending claims (1-8, 10, 11 and 19-23) were rejected under 35 U.S.C. § 112 and under 35 U.S.C. § 103.

Claim Rejections – 35 U.S.C. § 112

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner stated that "it seems clearly proper to characterize the invention as a 'repositionable label' ... rather than just the vague and indefinite statement 'article.'" However, the Applicants would like to point out that claim 1 recites a backing, a layer of repositionable non-pressure sensitive adhesive, and an optical recording medium. As such, it would not be appropriate to recite only a repositionable label in the preamble of the claim, since the optical recording medium is not part of the label. Claim 1 is therefore not indefinite for reciting an article in the preamble, and the rejection of claim 1 under 35 U.S.C. § 112 should be withdrawn.

The Examiner also pointed out that "In claim 2 applicants should be aware that they are claiming a 'block copolymer elastomer,' not a 'block copolymer.'" With this Amendment, claims 2 and 3 have been amended to further limit the element recited in claim 1 (a thermoplastic block copolymer elastomer) by stating that the thermoplastic block copolymer elastomer comprises at least one (claim 2) or 10-30% (claim 3) polystyrene block. Accordingly, the rejection of claims 2 and 3 under 35 U.S.C. § 112 should be withdrawn.

The Examiner also indicated that "In claim 10 it is believed that it should be 'pounds per a unit area,' not just 'pounds.'" However, the usage in claim 10 is consistent with paper industry standards, and the listed weight of 20/50 pounds refers to a weight of 20 pounds bond and 50 pounds text. This means, in paper industry parlance, that 500 sheets of 17" x 22" paper ("bond" size) weigh 20 pounds, and that 500 sheets of 25" x 38" paper ("text" size) weigh 50 pounds. Since claim 10 conveys a definite scope to a skilled artisan, the rejection of claim 10 under 35 U.S.C. § 112 should be withdrawn.

Finally, the Examiner indicated that "in claim 20 it appears desirable to change 'adhesive' to a -repositionable non-pressure sensitive adhesive-." With this Amendment, the change suggested by the Examiner has made, and the rejection of claim 20 under 35 U.S.C. § 112 should accordingly be withdrawn.

In view of the foregoing remarks and amendments, it is respectfully submitted that all rejections under 35 U.S.C. § 112 have been addressed and overcome.

Claim Rejections - 35 U.S.C. § 103

Claims 1-8, 10, 11 and 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over either EP-263 or Bird, each combined with the Applicants' admissions in the specification at page 2, lines 8-11 and 20-22 and page 3, lines 1-4 and 18-21. The reasoning given for the rejections is that EP-263 and Bird each disclose adhesive tapes that are repositionable, where the adhesive employed is a low tack or tack-free elastomeric block copolymer adhesive, and the admissions in the specification are that pressure sensitive adhesive labels for optical discs are well known and it is imperative that the label must also be precisely positioned onto a disc. The Examiner also contends that "applicants admit that pressure sensitive adhesives can be undesirable in making it unwieldy to position the label and that therefore there has developed a great need to have a repositionable and reusable disc layer which would allow a user to position the label to the disc without difficulty." The Examiner then concluded that one of ordinary skill in the optical recording medium art would have more than ample motivation to look to the repositionable adhesive art and utilize a label coated with a member of the genus of adhesives that are set forth in either EP-263 or Bird. The claimed performance parameters constituting the Dahlquist criterion was found by the Examiner to "be either inherent in either of the reference genus of adhesives or at most an obvious optimization to one of ordinary skill."

With this Amendment, claim 1 has been amended to include the recitation previously found in claim 4 (which has been canceled without prejudice), that the adhesion of the repositionable non-pressure sensitive adhesive is greater than 3 ounces per inch on the first major surface of the optical recording medium and is less than 3 ounces per inch on skin and paper. Neither EP-263 nor

Bird disclose this selective adhesion to an optical disc. Combining the teachings of EP-263 or Bird with the desire to make an optical disc label that is repositionable would yield an optical disc label that has either consistently low adhesion to common substrates or consistently high adhesion to common substrates. The combination proposed by the Examiner does not disclose the selective adhesion to an optical disc recited in amended claim 1. In order to reject a claim as obvious over a combination of references under 35 U.S.C. § 103, the references when combined must teach or suggest all of the elements of the claim. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). Since the combination proposed by the Examiner does not teach or suggest all of the elements of amended claim 1, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

With this Amendment, claim 5 has been amended to depend from amended claim 1.

Claims 2, 3, 5-8, 10, 11 and 19 depend from amended claim 1, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 2, 3, 5-8, 10, 11 and 19 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claim 20 recites an article having a layer of adhesive that has greater adhesion to the first major surface of an optical recording medium than to skin and paper. For the same reasons discussed above with respect to amended claim 1, the combination proposed by the Examiner to reject claim 20 does not teach or suggest the recited selective adhesion to the optical recording medium, and the rejection of claim 20 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

With this Amendment, claim 21 has been canceled without prejudice.

Claims 22 and 23 depend from claim 20, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 22 and 23 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

CONCLUSION

In view of the foregoing, all pending claims 1-3, 5-8, 10, 11, 19, 20, 22 and 23 are in condition for allowance. A notice to that effect is respectfully requested.

The Commissioner is hereby authorized to charge any fee required under 37 C.F.R. 1.16 and 1.17 and credit any overpayments to Deposit Account No. 11-0982. A duplicate copy of this paper is enclosed.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 1/29/04

By 

Alan M. Koenck, Reg. No. 43,724
THE KINNEY & LANGE BUILDING
312 South Third Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

AMK